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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,752	01/09/2006	Yasuhiro Matsumoto	001560-589	3766
21839	7590	02/18/2009	EXAMINER	
BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404				LACLAIR, DARCY D
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE			DELIVERY MODE	
02/18/2009			ELECTRONIC	

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Attachment to Advisory Action

Applicant's response filed **1/30/2009** has been fully considered but it is not persuasive.

Specifically, applicant argues **(A)** The scope of the "plastics" referred to by Napier can only be understood in terms of the kinds of elastomeric materials in which fibrous boehmite can be used analogous to rubber, and Napier is directed to improvements of elastomeric plastics analogous to rubber, or those having rubber-like properties, **(B)** The problem solved by the present invention is not directed to increasing strength and abrasion resistance of an elastomeric plastic, rather to improving thermal conductivity and mechanical strength in a phenol resin and **(C)** There would be no reason for a person of ordinary skill to combine the technical features of Schreiber '911 and '484 and Napier because there are no common technical features of the resin compositions described in the respective disclosures, and accordingly there are no common problems to be solved.

With regard to argument (A), applicant has argued that with respect to the quotation from Napier, specifically,

Fibrous boehmite can be used in plastics in manners analogous, and in amounts comparable, to those described for the use in rubber. For example, fibrous boehmite can be used as a reinforcing filler in making plastic films, coatings, paints, adhesives, or other plastic articles. (col 12 line 7-11)

that this teaching is meant to pertain only to elastomeric plastics analogous to rubber. Contrary to applicant's assertion, this describes the use of the boehmite in plastics in a **manner** analogous to that described for the use in rubber, not in plastics analogous to rubber. Specifically, it could be used as a reinforcing filler. Napier specifically

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enumerates films, coatings, paints, and adhesives, and further indicates other plastic articles. Schreiber teaches a phenol-formaldehyde resin, (see '911 col 2 Equation A, '484, col 1 Equation A) which most certainly falls within the scope of "plastics" which can be used for electric insulating materials (often placed as a film or coating), supporting structures (articles), or adhesives. (See '911 col 7 line 52-58) This constitutes an overlapping end use of the plastics described by Napier and the phenol-formaldehyde resins (plastics) described by Schreiber.

With regard to argument (B) and (C), applicant has argued the motivation for combining the Schreiber and Napier references is not consistent with applicant's motivation for combining, specifically that neither Napier nor Schreiber use the boehmite for improving the thermal conductivity and mechanical strength of the resin. Napier describes a use of boehmite as a reinforcing filler in plastics, which would improve the mechanical strength of the plastic. (See col 12 line 10) Napier also suggests the use of boehmite to improve abrasion resistance. (see col 11 line 74) Napier makes it clear that the boehmite can be used in plastics in an analogous manner as they are used in rubber, and therefore it would be expected that the boehmite, which is a hard filler, would provide abrasion resistance when used in plastic as well. Contrary to applicant's apparent assertion, abrasion resistance in a plastic article is a desired physical property, and one of ordinary skill in the art would therefore be expected to recognize such a benefit, provided by the boehmite material, for plastics, as Napier indicates. Therefore, Napier has given several clear motives to incorporate the boehmite in a plastic filler. Namely, the boehmite will provide reinforcement and abrasion resistance. Although

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Napier uses the boehmite in a different capacity than applicant, case law holds that it "does not alter the conclusion that its use in a prior art composition would have been *prima facie* obvious from the purpose disclosed in the reference." *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). While this motivation may not be the same motivation as in the present invention, it is noted that obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation. *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1996).

/D. D. L./

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